



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Am

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,488	06/13/2001	Daylan B. Darby	PW 028 0173 P11668	5256

7590 06/15/2005

Sharmini N. Green
c/o BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EXAMINER

HU, JINSONG

ART UNIT PAPER NUMBER

2154

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,488

Applicant(s)

DARBY, DAYLAN B.

Examiner

Jinsong Hu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-30 are presented for examination. Claims 1, 13, 19 and 26 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by IwaZaki (US 6,687,742).
4. As per claim 1, IwaZaki teaches the invention as claimed including a data structure for an electronic mail file comprising a first portion comprising combined electronic mail data [Text, Fig. 4] and variable meta-data information [Attached Image, Fig. 4; col. 7, lines 13-27]; and a second portion comprising a header [Header, Fig. 4] with link to information capable of monitoring changes in the variable meta-data information, the information additionally capable of identifying

Art Unit: 2154

a location of the electronic mail data within electronic mail file [col. 6, lines 28-54; col. 11, lines 46-63].

5. As per claims 2-4, IwaZaki teaches the header includes a link to a start of the electronic mail data, a link to an electronic mail sender and a link to an electronic mail recipient [Header, Fig. 4].

6. As per claim 5, IwaZaki teaches the header operates as an encoder and monitors changes to the variable meta-data information [col. 6, lines 28-39].

7. As per claim 6, IwaZaki teaches the header operates as an encoder and monitors a location of the electronic mail data within the file [Message-ID in Header, Fig. 4].

8. As per claim 7, IwaZaki teaches the meta-data information is referenced in the header [col. 8, lines 13-25].

9. As per claims 8-12, since they are method claims of claims 1-7, they are rejected for the same basis as claims 1-7 above.

10. As per claims 13-18, since they are computer program claims of claims 1-7, they are rejected for the same basis as claims 1-7 above.

Art Unit: 2154

11. As per claims 19-25, since they disclose the same limitation as claims 1-7 from different prospect (i.e., sender and receiver), they are rejected for the same basis as claims 1-7 above.

12. As per claim 26, IwaZaki teaches the invention as claimed including a method of providing an electronic mail file from a sending computer to at least one receiving computer within a data communication network comprising: establishing a simple mail transfer protocol (SMTP) session between the sending computer and the at least one receiving computer, generating commands by the sending computer, sending the commands to the at least one receiving computer [col. 6, lines 49-54]; and sending replies from the at least one receiving computer to the sending computers wherein the electronic mail file includes combined electronic mail data [Text, Fig. 4] and variable meta-data information [Attached Image, Fig. 4; col. 7, lines 13-27] and a header containing links to meta-data information and to a location of the electronic mail data within electronic mail file [col. 6, lines 28-54; col. 7, lines 40-50; col. 11, lines 46-63].

13. As per claim 27, IwaZaki teaches the data communication network includes an Internet or Intranet [13, Fig. 1].

14. As per claim 28, IwaZaki teaches the header includes a link to a start of the electronic mail data, to an electronic mail sender, and to an electronic mail recipient [Header, Fig. 4].

Art Unit: 2154

15. As per claim 29, IwaZaki teaches the header monitors changes to the meta-data information and monitors a location of the electronic mail data within the file [Message-ID in Header, Fig. 4].

16. As per claim 30, IwaZaki teaches the meta-data information is referenced in the header [col. 8, lines 13-25].

Conclusion

17. Applicant's arguments filed on 1/20/05 for claims 1-30 have been fully considered but they are not deemed to be persuasive.

In the remarks, applicant argued in substance that (1) IwaZaki does not teach the newly added limitation in claim 1; (2) IwaZaki does not teach combining a single file electronic mail data and variable meta-data information; (3) IwaZaki does not teach sending and receiving electronic mail files; (4) IwaZaki does not teach the newly added limitation in claim 26.

18. Examiner respectfully traverses applicant's remarks:

A. As to points (1) and (4), applicant fails to consider the teaching of the IwaZaki for combining electronic mail data [Text, Fig. 4] and variable meta-data information [Attached Image, Fig. 4; col. 7, lines 13-27]; and a second portion comprising a header [Header, Fig. 4] with link to information capable of monitoring changes in the variable meta-data information, the information

Art Unit: 2154

additionally capable of identifying a location of the electronic mail data within electronic mail file [col. 6, lines 28-54; col. 11, lines 46-63]. Thus, IwaZaki does teach the newly added limitation in claims 1 and 26.

B. As to point (2), applicant fails to consider the teaching of the IwaZaki for combining electronic mail data [Text, Fig. 4] and variable meta-data information [Attached Image, Fig. 4; col. 7, lines 13-27], i.e., that is a single file as applicant claimed in claim 8. Thus, IwaZaki does teach the limitation in claim 8.

C. As to point (3), applicant fails to consider the teaching of the IwaZaki for sending and receiving electronic mail files [col. 4, line 51 – col. 5, line 26].

Accordingly, IwaZaki is a relevant prior art reference.

19. THIS ACTION IS MADE FINAL. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

20. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing

Art Unit: 2154

date of this final action.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinsong Hu whose telephone number is (571) 272-3965. The examiner can normally be reached on 8:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinsong hu

June 10, 2005



VIET D. VU
PRIMARY EXAMINER